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09/196,029 11/19/98 NEMOTO

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EXAMINER

STEPHEN D SCANLON
TAROLLI SUNDHEIM COVELL TUMMINO & SZABO
1111 LEADER BUILDING
526 SUPERIOR AVENUE
CLEVELAND OH 44114-1400

DICKSON, P

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/196,029
Filing Date: November 19, 1998
Appellant(s): NEMOTO, HIROSHI

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed January 22, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendments after final rejection filed on November 13, 2000 and December 11, 2000 have been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 16-18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 16-18 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball*

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Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A

broadening aspect is present in the reissue which was not present in the application for patent.

The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 16-18 are broader than any of the original claims by the omission of at least the following limitation which was surrendered in the application for the patent:

- a. the limitation that the apparatus comprises an inner cover, the inner cover having a first tear seam.

The record constitutes an admission by the applicant that the limitation was necessary to overcome the prior art.

Reference is made to the amendment filed May 28, 1996, page 2, 2nd full paragraph:

It is respectfully submitted that claims 6-8 are allowable. Specifically, claim 6 recites an apparatus comprising an inner cover, an outer cover, and a horn switch disposed between the inner and outer covers. The horn switch includes first and second overlying layers of electrically conductive material. The first layer includes a first portion with a first tear line aligned with first and second tear seams in the inner and outer covers. The second layer includes a second portion spaced apart from the first portion with a second tear line. The second tear line is aligned with the first and second tear seams. The second tear line is spaced apart from the first tear line along a line extending along the first and second tear lines. The horn switch is rupturable along the first and second tear lines upon inflation of an air bag. None of the prior art discloses or suggests an apparatus as set forth in claim 6.

Reference is made to the amendment filed December 11, 1995, the paragraph bridging pages 5 and 6, specifically page 5, lines 21-26,

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The apparatus comprises an inner cover at least partially enclosing the air bag. The inner cover includes means for defining a first tear seam in the inner cover along which the inner cover ruptures upon inflation of the air bag to enable deployment of the air bag.

and page 6, lines, 4-11:

The first layer includes a first portion with a first tear line aligned with the first and second tear seams in the inner and outer covers. The second layer includes a second portion spaced apart from the first portion with a second tear line aligned with the first and second tear seams in the inner and outer covers and spaced apart from the first tear line along a line extending along the first and second tear lines.

Reference is made to the amendment filed December 11, 1995, page 6, lines 14-27:

None of the prior art...suggests an apparatus comprising an inner cover including means for defining a first tear seam in the inner cover, an outer cover including means for defining a second tear seam in the outer cover and a horn switch disposed between the inner and outer covers including first and second layers of electrically conductive material wherein the first layer includes a first portion with a first tear line aligned with the first and second tear seams in the inner and outer covers and the second layer includes a second portion spaced apart from the first portion with a second tear line aligned with the first and second tear seams in the inner and outer covers and spaced apart from the first tear line along a line extending along the first and second tear lines.

(11) Response to Argument

Claim 16

The appellant argues that no subject matter has been surrendered by the referenced arguments as such arguments are "a general statement regarding the patentability of claim 6 as a whole and specific to no one limitation (i.e., a "boiler plate" format)." The examiner maintains that the referenced arguments are specific to the inner cover and the first tear seam. Particular reference is made, but not limited to the amendment filed December 11, 1995, page 6, lines 14-27 wherein the applicant specifically refers to the "inner cover". From at least the above

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referenced paragraph, the examiner contends that the appellant specifically argued that the inner cover and the first tear seam in the inner cover were critical limitations.

The appellant argues that “at no time was there an argument that inner and outer covers are critical to patentability.” The examiner again directs attention to the above referenced paragraphs wherein the “inner and outer covers” are argued.

Claim 17

The appellant argues that as claim 17 includes allowable subject matter, “claim 17 does not recapture subject matter surrendered in the prosecution of the original application.” The examiner notes that claim 17 is broader in certain aspects and narrower in others. The broadening aspect of claim 17 relates to subject matter previously surrendered as discussed above with respect to claim 16. The newly added narrowing limitation in claim 17 does not modify the claim such that the scope of the claim no longer results in a recapture.

Claim 18

The appellant argues that as claim 18 includes allowable subject matter, “claim 18 does not recapture subject matter surrendered in the prosecution of the original application.” The examiner notes that claim 18 is broader in certain aspects and narrower in others. The broadening aspect of claim 18 relates to subject matter previously surrendered as discussed above with respect to claim 16. The newly added narrowing limitation in claim 18 does not modify the claim such that the scope of the claim no longer results in a recapture.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Paul N. Dickson
Primary Examiner
Art Unit 3618

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fbv *FBV*
amb *amb*

March 22, 2001

STEPHEN D SCANLON
TAROLLI SUNDHEIM COVELL TUMMINO & SZABO
1111 LEADER BUILDING
526 SUPERIOR AVENUE
CLEVELAND, OH 44114-1400